

REMARKS

Previously claims 1-22 were pending in this application. Claims 1-3 and 7-8 are being amended herein. Claims 5-6 and 9-22 are being cancelled. New claims 23-34 are being added. After entry of this amendment, claims 1-4, 7-8, and 23-34 will be pending. No new matter is introduced by way of this amendment.

The Office Action dated October 22, 2004 rejected claims 1-6, 8-10, 12-15 and 19 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,591,116 to Laurila et al. (the Laurila et al. patent). The Office Action also rejected claims 7, 11 and 20 under 35 U.S.C. §103(a) as being unpatentable over the Laurila et al. patent in view of U.S. Patent No. 6,683,853 to Kannas (the Kannas patent). Finally, the Office Action also rejected claims 16-18 and 21-22 under 35 U.S.C. §103(a) as being unpatentable over the Laurila et al. patent in view of U.S. Patent No. 6,157,845 to Henry et al. (the Henry et al. patent).

Claims 1-3 and 7-8 are amended herein in the interest of furthering prosecution. In particular, amended base claim 1 now recites in pertinent part “transmitting query messages on the wireless subsystem from the handset to the data base to retrieve the capability data.” Base claim 2 recites similar limitations clarifying that the handset is transmitting query messages to a database accessible over the wireless subsystem. Support for these amendments can be found throughout the specification, and at least at page 5, lines 9-10 and page 6, lines 1-3. Additionally, claim 2 is amended herein to correct a typographical error. No new matter is introduced by way of these amendments.

Briefly, the present invention provides a system and method for selecting the operating mode of a multi-mode handset by providing data indicative of the operating mode capability of a wireless subsystem or particular base station(s) to a wireless handset so that the handset can be switched or operated in a mode that corresponds to those preferably enhanced capabilities. In particular, a database is provided that contains data indicative of the operating mode capability of the wireless subsystem or base station(s) within the subsystem. A handset operating in a first mode transmits query messages to the database through the wireless subsystem (e.g., base station) to retrieve the capability data of the wireless subsystem or particular base station(s). The handset is then switched or operated in a second mode if the retrieved capability data indicates that the subsystem or base station is capable of operating in the second mode. This reduces

system complexity and avoids increased operating costs by enabling use of an enhanced capability at one or more wireless subsystems without first requiring that the wireless subsystems be upgraded to permit signaling of the availability of the enhanced capability. Such features are now recited in base claims 1 and 2 as amended herein.

Turning attention briefly to the prior art, the Laurila et al. patent describes a mobile device that includes a data storage module, referred to as a Subscriber Identity Module (SIM)/USIM or UICC. This data storage module is described as being readably coupled to a controller that is included within the mobile equipment. (Laurila, col. 3, ln. 11-19). For example, the SIM/USIM is preferably a removable data card that is coupled to the mobile equipment. (Laurila, col. 4, ln. 36-39).

Additionally, the data storage module stores information for specifying the operational capabilities of the module. (Laurila, col. 3, ln. 19-21). As the module is readably coupled to the mobile device and contains applications for the different networks (e.g., GSM and UMTS applications), it is an indication as to the capabilities of the mobile device itself. Thus, the mobile device uses the SIM to inform a visited network as to the capabilities of the applications of the mobile device. This then allows the network, as opposed to the mobile device, to select and use the latest applications and features supported by the mobile device. In particular, the mobile device includes a controller that is responsive to a request from the visited network for information concerning the mobile device's capabilities. (Laurila, col. 2, ln. 58 through col. 3, ln. 26).

Claim Rejections - 35 U.S.C. §102

Claims 1-6, 8-10, 12-15 and 19 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,591,116 to Laurila et al. (the Laurila et al. patent). We disagree.

As an initial matter, the rejection of claims 5-6, 8-10, 12-15 and 19 are moot as these claims are canceled herein.

As amended, base claim 1 now recites “transmitting query messages on the wireless subsystem from the handset to the data base to retrieve the capability data.” The Laurila et al. patent does not anticipate claim 1 at least because query messages are not transmitted on the wireless subsystem as now claimed. The Examiner had suggested that transmitting query

messages on the system reads on the SIM/USIM system described in the Laurila et al. patent. Namely, that transmitting query messages reads on “the mobile equipment 10 request[ing] the capability information stored in the SIM/USIM card, i.e., the UICC 28.” (Laurila, col. 6, ln. 37-51).

The Laurila et al. patent fails to teach or suggest “transmitting query messages on the wireless subsystem from the handset to the data base to retrieve the capability data.” At most, the Laurila et al. patent describes transmitting query messages from the mobile equipment 10 to a data storage module coupled to the mobile equipment. The data storage module (e.g., SIM/USIM card) is described as being readably coupled to the controller 18, which is included in the mobile equipment 10. For example, in a preferred embodiment the data storage module is a removable data card (i.e., UICC 28) that is actually part of the mobile equipment 10. (Laurila, col. 4, ll. 36-39, see also Fig. 1). Thus, it would not be necessary for the mobile equipment 10 to transmit any query messages over the wireless telecommunications network 32, as the data storage module is directly coupled to the mobile equipment. Accordingly, the Laurila et al. patent fails to teach or suggest at least “transmitting query messages on the wireless subsystem from the handset to the data base to retrieve the capability data.”

The Examiner is also of the opinion that a database containing data indicative of the operating mode capability of the wireless subsystem, as claimed is inherent to the SIM/USIM data storage module. That is incorrect. Rather, the SIM/USIM module only contains information regarding the operational capabilities of the mobile device itself. (Laurila, col. 3 lns. 19-22). A SIM/USIM does not contain information indicative of the operating mode capability of the wireless subsystem or base station(s) within the subsystem to which the mobile device is connected. As further distinguished by the amended claims, data indicative of the operating mode capability is obtained by transmitting query messages from the handset through the wireless subsystem, or base station, to the database to retrieve capability data.

In other words, the handset described in the system of the Laurila et al. patent is not capable of handling the situation as shown in Applicants’ Fig. 2, in which a second mode may have enhanced capabilities that are not known a priori to the handset.

For at least these reasons, the Laurila et al. patent does not teach or suggest associating a database with a data communication system containing data indicative of the operating mode

capability of the wireless subsystem or particular base station(s) within the wireless subsystem, transmitting query messages on the wireless subsystem from the handset to the database to retrieve such capability data, and switching or operating the handset in a mode indicated by the retrieved capability data.

Thus, base claim 1 is novel and non-obvious over the prior art of record for at least these reasons. Applicants respectfully request that the Examiner reconsider and withdraw the §102(e) rejection of base claim 1.

Base claim 2 recites similar limitations and is therefore allowable for the same reason as base claim 1.

Further, by virtue of at least their dependency on base claim 2, dependent claims 3-4 and 7 are also allowable.

Claim Rejections - 35 U.S.C. §103

Claims 7, 11, and 20

Claims 7, 11 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Laurila et al. in view of U.S. Patent No. 6,683,853 to Kannas (the Kannas patent). The rejection with respect to claims 11 and 20 are moot as these claims are cancelled herein. As for claim 7, this claim is directed to an additional feature in which the database is designated as a second Internet destination port for the handset. With respect to the Laurila et al. patent, the foregoing arguments still apply, and the Examiner actually acknowledged that the Laurila et al. patent does not teach this additional feature.

The Kannas patent fails to correct or supply the teachings missing from the Laurila et al. patent. Namely, the Kannas patent fails to teach or suggest “transmitting query messages on the wireless subsystem from the handset to the data base to retrieve the capability data.” The Kannas patent merely describes that an Internet server can communicate with a wireless subscriber unit over a radio and core (wired) networks. (See Kannas, col. 3, lines 31-56). Thus, the Kannas patent does not teach or suggest a database containing data indicative of the operating mode capability of the wireless subsystem or particular base station(s) within the wireless subsystem, transmitting query messages on the wireless subsystem from the handset to the database to retrieve such capability data, and switching or operating the handset in a mode

indicated by the retrieved capability data. Moreover, the Kannas patent does not teach or suggest that such a database can be designated as a second Internet port of a handset that can be queried for capability data of the wireless subsystem or particular base station(s) within the wireless subsystem. Thus, neither the Laurila et al. patent, nor the Kannas patent, nor their combination teach or suggest every limitation of claim 7.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of claim 7.

Claims 16-18 and 21-22

Claims 16-18 and 21-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Laurila et al. in view of U.S. Patent No. 6,157,845 to Henry et al. (the Henry et al. patent). The rejection with respect to 16-18 and 21-22 is moot as these claims are cancelled herein.

Patentability of New Claims 23-34

New claims 23-34 recite similar limitations as base claims 1 and 2 and are therefore patentable for the same reasons argued above.

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CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Ralph Tremontozzi
Ralph Tremontozzi
Registration No. 55,686
Telephone: (978) 341-0036
Facsimile: (978) 341-0136

Concord, MA 01742-9133
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